REMARKS/ARGUMENTS

This response and request for continued examination are filed in response to the Advisory Action mailed Dec. 30, 2003.

Rejection under 35 USC §101

The December 30, 2003 Advisory Action rejected pending claim 20 under 35 USC §101 on the grounds that claim 20 was not directed to technological arts. It is respectfully submitted that as amended herein claim 20 is clearly directed to the technological arts. Thus, it is submitted that this rejection is overcome and reconsideration is requested.

Rejection under 35 USC §102

The December Advisory Action also rejected pending claim under 35 USC §102, stating that the method of the claim "a non-linear optimization was disclosed by an 'economic module' (see at least fig. 3 and associated text) in which return scenarios are simulated repeatedly for optimal results." It is assumed, based on the 10/3/03 Office Action in this matter, that the reference being referred to is the US patent no. 6,021,397 to Jones et al.

The rejection of claim 20 appears to be based in part on the position that any optimization routine is the equivalent another optimization routine, and it is respectfully submitted that this is not the case. Indeed claim 20 recites specific elements of the optimization routine utilized in the method of claim 20, and it is respectfully submitted that this combination of elements does not appear to be disclosed in or suggested the '397 patent. Specifically, claim 20 as amended recites in part: "providing a processor programmed to ~~performing~~ perform an optimization which includes the data for the taxable investments, the data for the non-taxable investments and the investor profile information and which takes into account capital gains or losses on taxable investments which would be sold."

The optimization of claim 20 clearly recites significant limitations regarding the steps of the optimization. These limitations include: "performing an iterative non-linear optimization routine, and the optimization routine comprises a first subroutine of attempting to resolve a flat function problem by running the routine with different sets of initial values, and the optimization routine further includes a second subroutine". The claim further recites: "wherein when the flat function does not optimize with any of the sets of initial values used in an initial step, the second

subroutine is utilized, wherein the second subroutine includes: taking a solution for a best case; and re-running the optimization routine including only those investments with nonzero weights". The claim then recites: "wherein when an optimal solution is found using the first subroutine, performing a third subroutine of re-running the optimization routine to account for minimum investment values; and

wherein when an optimal solution is found using the second subroutine, performing the third subroutine of re-running the optimization routine to account for minimum investment values."

A review of the '397 patent fig. 3, and the related discussion, see for example 17:15-18:50 discusses optimization, but this discussion does not appear to contemplate a optimization as recited by claim 20. For example, claim 20 recites an optimization which utilizing a first subroutine to resolve a flat function problem by running the routine with different initial values. The method provides for recognizing when the flat function is not resolved, and then using a second subroutine which includes taking a best case solution and running the optimization using only nonzero weight investments. The method also requires that where an optimal solution is found using the first subroutine, the using of a third subroutine to run the optimization to account for minimum investment values. Finally, the method requires that this same third subroutine be used where an optimal solution is found using the second subroutine. For background information regarding an exemplary embodiment utilizing this method the Examiner is referred to the specification of the pending application, and for example pages 74-75.

The operation and relation between these three subroutines is something which does not appear to be disclosed in or suggested by the '397 patent. Thus, reconsideration is respectfully requested. Should the rejection of this claim continue be maintained, reference to the areas of the '397 patent which purportedly disclose the elements of an optimization is respectfully requested.

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CONCLUSION

For the reasons set forth above, it is believed that all claims present in this application are patentably distinguished over the references. Therefore, reconsideration is requested, and it is requested that this application be passed to allowance.

Respectfully submitted,

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